



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,069	09/26/2000	Laure Boymond	48937	3836

7590

12/17/2001

Keil Weinkauf
1101 Connecticut Avenue N W
Washington, DC 20036

EXAMINER

TIZIO, STEVEN C

ART UNIT

PAPER NUMBER

1627

DATE MAILED: 12/17/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Restriction/Election Only

Application No.

09/647,069

Applicant(s)

BOYMOND ET AL.

Examiner

Steven C Tizio

Art Unit

1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1627

DETAILED ACTION

Please note: In an effort to enhance communication with our customers and reduce processing time, Group 1627 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is (703) 305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this pilot program. If you have any questions or suggestions please contact Jyothnsa Venkat, Ph.D., Supervisory Examiner, at Jyothsna.Venkat@uspto.gov or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5, drawn to the process for preparing compounds of the general formula I.

Art Unit: 1627

Group II, claim(s) 6, drawn to the compound of the formula I.

Group III, claim(s) 7, drawn to the compound of the formula Ia.

Group IV, claim(s) 8, drawn to the use of a process in claim 1 for preparing substance libraries.

2. The inventions listed as **Groups I-IV** do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature of **Group I** is the process for preparing compounds of the general formula I, the special technical feature of **Group II** is the compound of formula I, the special technical feature of **Group III** is the compound of the formula Ia, and the special technical feature of **Group IV** is the use of a process in claim 1 for preparing substance libraries. The technical feature that links all of the claims is the Grignard compound shown in claim 1. The groups lack unity because the Grignard compound is known in the art as disclosed by Rhone-Poulenc (WO-A-97/05110) (see under "intermediate 8", page 24); Ikoma *et al.* (Chemical Abstracts, Vol. 118, No. 17, 1993) (see the abstract); Evans *et al.* (J. Chem. Soc. (A), 1967) (see Tables 1 and 2, section Experimental); Busch *et al.* (Chemical Abstracts, Vol. 86, No. 1, 1977) (see the abstract); and Kabalka *et al.* (Tetrahedron Letters, Vol. 38, No. 33, 1997) (page 5778, table). Thus the technical feature does **not** define a contribution which each of the claimed inventions, claimed as a whole, makes over the prior art.

Art Unit: 1627

3. This application contains claims directed to more than one species of the generic invention for Groups I and II. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are set forth as follows for each group with the claims corresponding to the species and the generic claim also set forth:

A. If Group I is elected, applicants are requested to elect a single species for the following:

(1) elect a value for z in **claim 1** ✓

(2) elect a single species of X (halogen, R^2) in **claim 1** ✓

(3) elect a single species of X^a (Br, I) in **claim 1** ✓

(4) elect a single species of A, B, D and E from the group of constituents consisting of CH, CR^2 , N, P, or CR^3 in **claim 1** ✓

(5) elect a single species of F, depending on the value of Z, in **claim 1** ✓

(6) elect a single species of the substituted or unsubstituted ring structure including the selection of ring size, number and type of heteroatoms, and specific connectivity in **claim 1** ✓

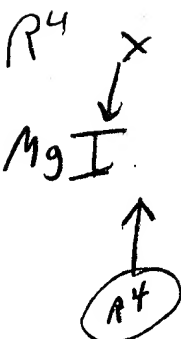
(7) elect a single species of R^1 in **claim 1**

(8) elect a single species of R^2 in **claim 1**

(9) elect a single species of R^3 in **claim 1**

(10) elect a single species of $R^{3'}$ in **claim 1**

? (11) elect a single species of R^4 in **claim 1**



Art Unit: 1627

~~(12)~~ elect a single species of R^5 (solid support) in **claim 1**

~~(13)~~ elect a single species of R^6 in **claim 1**

B. If **Group II** is elected, applicants are requested to elect a single species for the following:

(1) elect a single species of R^1 in **claim 6**

C. If **Group III** is elected, applicants are requested to elect a single species for the following:

(1) elect which R group (R^2 , R^3 or R^3') will be the polymeric protective group, in addition to specifying multiple protective groups in **claim 7**

(2) elect a single species of polymeric protective group in **claim 7**.

4. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

5. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

6. The claims are deemed to correspond to the species listed above in the following manner: The following claim(s) are generic: 2-5 and 8.
7. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the special technical feature of each group is different and do not require the other for ultimate use. So species election among the above is proper.

For search purposes, applicants should provide the chemical structure of each species, the specific chemical formula substituents of those species are defined either by picture or by expressing the species in terms of the variables of the formula.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR .143).
9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

Art Unit: 1627

remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

10. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Tizio whose telephone number is (703) 305-1903. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


PADMASHRI PONNALURI
PRIMARY EXAMINER

Steven C. Tizio
Patent Examiner
Technology Center 1600
AU 1627